

## **REMARKS**

The Office Action mailed December 10, 2003 has been received and carefully considered. Claims 1-50 are currently pending in the application, of which claims 14-44 and claim 48 are withdrawn from examination. Claims 1-13, 45-47 and 49-50 stand rejected. Claims 1-13, 45-47, and 49-50 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 58-71 of U.S. Patent No. 6,491,394 to Blum et al. (the "Blum '394 Patent"). Claims 1-8, 10-13, 45-47 and 49-50 stand rejected under 35 U.S.C. § 102(e) as anticipated by the Blum '394 Patent. Claims 1, 4-8, and 10-13 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,359,444 to Piosenka et al. ("Piosenka") in view of U.S. Patent No. 5,488,439 to Weltmann ("Weltmann"). Claims 45-47 and 49-50 stand rejected under 35 U.S.C. § 103(a) as being obvious over Piosenka in view of U.S. Patent No. 5,615,588 to Gottschald ("Gottschald"). The Patent Office has objected to claim 9 and indicated this claim is directed to patentable subject matter, for which Applicants express their appreciation.

### **I. Amendments to the Specification**

The Examiner has objected to the drawings because the "Brief Description of the Drawings" section does not include a description of Figures 37f and 37g. The specification has been amended to include Figures 37f and 37g with the brief description of Figures 37a-e, to which Figures 37f and 37g are related. Applicants respectfully submit that this amendment to the specification overcomes the objection. No new matter is added by this amendment.

## **II. Amendments to the Claims**

Applicants note that the Examiner has made final the restriction requirement mailed May 6, 2003. Claims 14-46 and claim 48 directed to the non-elected invention and which were withdrawn from examination by the Examiner have been cancelled. Applicants reserve the right to file one or more divisional applications directed to the cancelled claims and any other subject matter disclosed or claimed in the Application as filed.

## **III. Double Patenting Rejection**

Claims 1-13, 45-47, and 49-50 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 58-71 of the Blum '394 Patent. The Blum '394 Patent is owned by E-Vision, LLC which is also the assignee of the Application. A terminal disclaimer is submitted herewith under 37 C.F.R. 1.321(c) along with the appropriate fees. The Applicants respectfully submit the filing of this terminal disclaimer is sufficient to overcome the double-patenting rejection.

## **IV. Rejection under 35 U.S.C. § 102(e)**

Claims 1-8, 10-13, 45-47 and 49-50 stand rejected under 35 U.S.C. § 102(e) as anticipated by the Blum '394 Patent. An affidavit in accordance with 37 C.F.R. § 1.132 is submitted herewith stating that the inventions disclosed, but not claimed in the Blum '394 Patent were derived from Applicants own invention. Thus, the claimed invention is not an invention "by another" as required for 35 U.S.C. § 102(e) to apply. Applicants respectfully submit the filing of this affidavit is sufficient to overcome the rejection and that the rejection should be withdrawn.

**V. Rejection of claims 1, 4-8, and 10-13 under 35 U.S.C. 103(a)**

Claims 1, 4-8, and 10-13 stand rejected as being obvious over Piosenka in view of Weltmann. Applicants respectfully traverse this rejection.

As stated by the Federal Circuit, “a proper analysis under 35 U.S.C. § 103 requires, *inter alia*, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success.” *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). In addition, the prior art reference(s) must teach or suggest all of the claim limitations. The teaching or suggestion to combine and the reasonable expectation of success must both be found in the prior art, and not in Applicant’s disclosure. *Id* at 493. *See also* M.P.E.P. § 2142.

Claim 1, from which claims 4-8, and 10-13 depend, is directed to an optical lens system comprising a first optical lens having a first region and a perimeter region, an electro-active refractive matrix coupled to the first region of the optical lens, the perimeter region of the lens being removable from the optical lens to configure the optical lens for a specific eyeglass frame.

The Patent Office has asserted that it would be obvious to combine the teachings of Piosenka with those of Weltmann to arrive at Applicants’ claimed invention. Piosenka is directed to eyeglasses that include lenses that contain liquid crystal nematic materials with variable refractive indexes. Piosenka, Abstract. The lenses are optically transparent, hollow shells filled with a liquid optically anisotropic material. Piosenka, col. 3, lines 35-37. The

material is introduced into the shell through an opening that is later sealed. Piosenka, col. 3, lines 40-42.

Weltmann is directed to a lens holder system for temporarily holding a prescription lens in the openings of eyeglass frames. Weltmann, Abstract. The lens holder has a prescription lens that is retained in a lens encircling portion. The lens encircling portion is a U-shaped metal band clamped around the lens. The lens holder also has a pair of spring wires attached at first ends to opposite sides of the lens encircling portion and second ends are slidably retained by spring wire guides located on the lens encircling portion. Weltmann, col. 3, lines 17-19. The spring wires are placed within channels of an eyeglass frame.

Unlike Applicants' claimed invention, Weltmann is directed to an eyeglass holder that permits removing lenses from eyeglass frames - not to removing a portion of the lens (i.e. the perimeter region) from the lens to fit within a particular eyeglass frame. Nowhere does either Weltmann or Piosenka teach, disclose or suggest removing material from an optical lens to fit the lens within a specific eyeglass frame, and one of ordinary skill in the art would not be motivated to do so based upon these references. At most, Weltmann teaches that a lens can be clamped in a lens holder for insertion into various eyeglass frames, provided that those frames have a channel to receive the spring wires of the lens holder.

As all of the elements of the claim have not be disclosed, taught or suggested by the cited references, a prima facie case of obviousness has not been presented. Therefore, Applicants respectfully submit that the rejection should be withdrawn.

**VI. Rejection of claims 45-47 and 49-50 under 35 U.S.C. 103(a)**

Claims 45-47 and 49-50 stand rejected as being obvious over Piosenka in view of Gottschald. Applicants respectfully traverse this rejection.

Claims 45, from which claims 46 and 47 depend is directed to a method of assembling eyewear comprising providing a lens system having an electro-active refractive matrix, the lens system also having a fixed outer surface, modifying the shape of the lens system by edging an outer perimeter of the lens system, and placing the lens system into an eyewear frame. Claim 49, from which claim 50 depends is directed to a method of assembling an optical lens system comprising providing a lens blank having an electro-active refractive matrix and removing material from the lens blank to configure the lens blank to fit within a specified eyeglass frame.

Gottschald teaches an apparatus for processing the edge of ophthalmic lenses. As discussed earlier, Piosenka is directed to lenses that are hollow shells filled with a liquid optically anisotropic material and then sealed. The Patent Office has asserted that it would have been obvious to use the apparatus of Gottschald with the lens taught by Piosenka to arrive at Applicants' claimed invention.

Contrary to the Patent Office's assertion, it would not be obvious to combine the teachings of Piosenka with Gottschald. Piosenka does not teach, disclose or suggest modifying or configuring the edge of the disclosed lenses to fit within a specific eyeglass frame. Likewise, Gottschald does not teach, disclose, or suggest processing the edge of ophthalmic lenses that include an electro-active refractive matrix. The only suggestion to modify a lens that comprises

an electro-active refractive matrix to fit within a specific eyeglass frame comes from Applicants' own invention, which requires the use of impermissible hindsight.

Not only does neither reference suggest the combination, one of ordinary skill in the art would not be motivated to combine them. One of ordinary skill of the art would not be motivated to modify Piosenka's lens using Gottschald's apparatus as there would be no expectation for success using Piosenka's hollow lens. The only perimeter region that the Patent Office identifies with respect to Piosenka's lens is the rim as shown in Figures 9 and 10. December 10, 2003 Office Action at pg. 7. Yet, were even a portion of this rim removed from Piosenka's hollow lens, such as by edging it using the lathe apparatus of Gottschald, the lens would no longer be sealed and the liquid crystals would drain from the lens. Thus, one of ordinary skill in the art would not be motivated to modify the lens of Piosenka with Gottschald's edging apparatus. Accordingly, Applicants respectfully submit that this rejection should be withdrawn.

### CONCLUSION

For at least the reasons stated above, claims 1-8, 10-13, 45-47, and 49-50 are in condition for allowance. Accordingly, Applicants respectfully request that the amendments be entered and the Application be allowed and passed to issue.

In the event any outstanding issues remain, Applicants would appreciate the courtesy of a telephone call to Applicants' undersigned representative to resolve such issues in an expeditious manner.

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Respectfully submitted,

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